

- (i) a "Declaration of Jean-Manuel Van Thong",
  - (ii) a "Declaration under Rule 131" by the Applicants of the patent application at hand,
- and
- (iii) supporting Exhibits A-G, where Exhibits A-B2 are referenced by both Declarations.

The subject matter disclosed in the cited reference (U.S. Patent No. 6,505,153) to Van Thong et al. at column 13, line 15 through column 21, line 3 under the subheading of Appendix II is the same as that disclosed in the internal company disclosure document (Exhibit A) that led to the subject patent application. The Declaration by Van Thong confirms this at paragraph 5 of that declaration.

Also, the Exhibit B2 document written by declarant Van Thong recites at page 8, section 4.3.3 that the method of linking user input with streaming data via time stamp trigger events is "...completely described in [Pat 5]". At paragraph 5 of the Van Thong Declaration, he states that this reference to "Pat 5" refers to the Exhibit A document.

Thus to declarant Van Thong at the time of writing the Exhibit B2 document (i.e., at least July 8, 1999, see Exhibit B1 cover message to Exhibit B2) the subject matter of the Exhibit A document was sufficiently described to incorporate into his closed caption system of U.S. Patent No. 6,505,153 as early as July 8, 1999 (the date of the cover page to Exhibit B2) and as late as the May 22, 2000 filing date of the cited U.S. Patent No. 6,505,153.

The Rule 131 Declaration by Davis Pan and James M. Rehg (joint inventors of the instant patent application), as corroborated by the Declaration of Jean-Manuel Van Thong, sets forth details of conception before the cited patent reference filing date (May 22, 2000) and due diligence from conception to reduction to practice of the present invention (whether the May 22, 2000 Van Thong patent filing date where Appendix II is a disclosure of the present invention or the September 15, 2000 subject application filing date). Briefly, the present invention was conceived at least as early as February 18, 1999 (see paragraph 3 of the attached Rule 131 Declaration), and constructively reduced to practice at least by the September 15, 2000 filing date of the subject patent application. Alternatively, constructive reduction to practice of the present invention is as early as the May 22, 2000 filing date of U.S. Patent No. 6,505,153 which contains a working disclosure of the present invention. Further, "due diligence" in accordance with 37

C.F.R. § 1.131(b) is shown by paragraphs 4. through 11. and supporting Exhibits C.-G. of the attached Rule 131 Declaration.

Accordingly, the present invention was not "...described in an application for patent..by another filed in the United States before the invention by the applicant...(emphasis added)" as required by 35 U.S.C. § 102(e). Restated, the present invention came before the cited patent by Van Thong which applies the present invention to an efficient closed caption system (and does not claim the present invention). Thus the § 102(e) rejection is believed to be overcome.

Acceptance of Claims 1-36 is respectfully requested.

### CONCLUSION

In view of the above amendments and remarks, it is believed that all claims are in condition for allowance, and it is respectfully requested that the application be passed to issue. If the Examiner feels that a telephone conference would expedite prosecution of this case, the Examiner is invited to call the undersigned.

Respectfully submitted,

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## INDEX OF EXHIBITS

- A        Company invention disclosure document for subject invention
- B1,B2    Company invention disclosure document for "An Efficient Method for Producing Off-line Closed Captions" by Van Thong et al. and email cover sheet
- C        Copy of email communications between company attorney and outside patent counsel
- D        Timeslips and billing statements of outside patent counsel
- E        Copies of email between inventors and outside patent counsel
- F1,F2    Copies of cover letters forwarding draft application to inventors
- G        Copy of cover letter forwarding revised draft application to inventors